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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,719	02/23/2004	Matthew B. Schoen	Schoen-P1-04	9452

28710	7590	04/16/2012
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EXAMINER	
MEINECKE DIAZ, SUSANNA M	

ART UNIT	PAPER NUMBER
3684	

MAIL DATE	DELIVERY MODE
04/16/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of	:	
Matthew B. Schoen et al	:	DECISION ON PETITION
Application No. 10/784,719	:	REGARDING RESTRICTION
Filed: February 23, 2004	:	REQUIREMENT
Attorney Docket No.: Schoen-P1-04	:	
For: Superstructure Pool Computer System	:	

Applicants' petition filed on May 31, 2011 requests withdrawal of the election requirement as set forth in the Office action mailed April 28, 2009 and thereafter made final in the Office action mailed February 2, 2010. Applicants further request an examination on the merits of all pending claims. The delay in treating this petition is regretted.

The petition is **DISMISSED**.

A review of the record reveals that the Office action mailed April 28, 2009 set forth an election requirement requiring a provisional election between species identified as Group A (species A-1 – A-22), Group B (species B-1 - B-5), Group C (species C-1 – C-3), Group D (species D-1 – D-5), Group E (species E-1 – E-2), and Group F (species F-1 – F-4). Applicants elected the species of Group A1 (claims 5, 85), B1 (claims 43,123), C3 (claims 51,131), D1(claims 52,132), E1 (claims 65,145), and F2(claims 162, 166) with traverse in the response filed October 28, 2009. The examiner, upon reconsideration, adhered to the election requirement and made the election requirement final. This petition was then timely filed.

Applicants' petition alleges that the election requirement is improper because there is significant overlap between the claims of the identified groups of invention due to the presence of generic claims and that the subject matter is sufficiently related such that a thorough search for the subject matter of the elected species would encompass a search for the subject matter of the other species and as a result that no serious burden on the examiner exists. Applicants have failed to show that search is the only criteria for determining "serious burden" on the part of the examiner. Nevertheless, it should be noted that the search for and examination, including consideration of and response to arguments, of the various specific features of multiple patentably distinct species in the same application creates a serious burden on the examiner when no allowable generic claim is indicated to be present.

Applicants' further allege that the examiner failed to explain how and why there would be series burden on the examiner in searching the claims because various classes and subclasses have not been established for each of the species. With respect to applicants' allegation that the examiner failed to explain how and why the claims were grouped as indicated, it should be noted that the examiner fully complied with Office procedure and practice, see MPEP 809.02(a), by clearly identifying each species by examples and distinguishing characteristic. Further, it is readily apparent from a review of the various examples for each identified species that the Examiner would have to search and find details in the context of specific natures of each respective type (22 distinctive types in Group A) of financial liability. Accordingly, it is evident that the examiner has identified patentably distinct species along the lines of the various financial liabilities

At the outset, it appears from applicants' arguments that applicants have not analyzed the examiner's action in the context of the established practice for requiring a provisional election of species requirement as established in Chapter 800 of the MPEP. In particular, it is a well-established practice that a requirement to elect a single disclosed species is a holding by the examiner that the plural species, as claimed, are patentably distinct, i.e., capable of supporting separate patents, see MPEP 808.01(a) and MPEP 809.02(a). If applicants are of a different view, then applicants need merely clearly state on the record that the species are not patentably distinct.

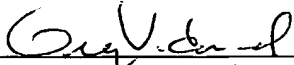
Lastly, it should be noted that Applicant has not argued the actual merits of the restriction requirement, e.g., by explaining how the different species are not mutually exclusive or by explaining how the different species are not obvious variants of one another or by explaining how the different species are not patentably distinct from one another.

With respect to the alleged presence of generic claims, it should be noted that the presence or absence of generic claims is not indicative of the propriety of an election requirement. A generic claim must be found to be allowable before there is any impact on a provisional election requirement, see MPEP 809.02(b) and MPEP 809.02(c). Further, note MPEP 806.04(d) for the definition of what constitutes a generic claim.

For the foregoing reasons, the examiner's provisional election requirement is proper.

SUMMARY: The Petition DISMISSED.

Any questions regarding this decision should be directed to Jason Dunham, Supervisory Patent Examiner, at 571-272-8109.


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JBD: 3/4/12

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